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Filed: 6 November 2003

For: BEAK TREATMENT WITH TONGUE PROTECTION

To support a *prima facie* case of obviousness under 35 U.S.C. §103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves, the knowledge generally available to one of ordinary skill in the art, or the nature of the problem involved, to modify a reference or combine reference teachings. Second, there must be a reasonable expectation of success (i.e., a reasonable expectation that the benefit result will be achieved). And third, the prior art reference(s) must teach or suggest all the elements and limitations of the claims of the Application. Applicants respectfully submit that the asserted obviousness rejection does not meet all the above criteria and, therefore, fails to set forth a *prima facie* case of obviousness.

As support for the rejection of claim 1, it is asserted that "[i]t would have been obvious to one of ordinary skill in the art to modify the teachings of Gorans with the teachings of Gourlandt at the time of the invention since the modification is merely changing/shifting the application point of the energy source to an alternate location while performing the same intended function modified further [*sic*] reduce injury caused by the bird peaking [*sic*] other birds." This assertion is not supported by the references themselves and cannot form the basis for a *prima facie* case of obviousness.

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01(V), p. 2100-137, 8th Ed. (Rev. 3, August 2005) (*citing In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

The proposed modification of *Gorans et al.* renders the invention unsatisfactory because one of the stated advantages of the devices and methods disclosed in *Gorans et al.* "is that the invention allows the bird to retain its lower beak which helps in eating and drinking." *Gorans et al.*, col. 2, lines 2-5 (emphasis added). To propose a modification in which the lower beak is removed is in direct contradiction with one of the stated advantages of the methods and devices of *Gorans et al.* As a result, a *prima facie* case of obviousness has not been established with respect to claim 1 of the present application.

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It is also asserted, in support of this rejection, that Gorans teaches "pressing inward on the throat of the bird proximate the base of the lower beak (Gorans Fig. 10 illustrates a hand pressing the bird inward to the device) wherein the pressing is directed towards the tongue of the bird (Gorans Fig. 5 lower portion of element #61 that comes in contact with element B inherently presses directed towards the tongue as the bird is pressed into the device). *Office Action*, p. 4 (August 12, 2005). Applicants disagree.

The text of *Gorans et al.* is silent with respect to pressing inward on the throats of the birds processed within the disclosed devices. The assertions presented above are based entirely on the Examiner's interpretation of the figures in *Gorans et al.* and, Applicants submit, the assertions are not supported by a review of the cited figures.

Although Figure 10 does depict the placement of a bird in the device, no portion of the device is depicted as "pressing inward on the throat of the bird proximate the base of the lower beak" as asserted in the Office Action. Rather, the bird's head is depicted being placed within the "bird head shaped opening 69" which is "specifically contoured to comfortably fit the poultry head H." *Gorans et al.*, col. 3, lines 57-58. In other words, no support is found for the assertion that, during use of the device, a portion of the opening 69 is "pressing inward on the throat of the bird proximate the base of the lower beak" as asserted in support of this rejection.

With respect to the assertion that Figure 5 of *Gorans et al.* depicts that "the pressing is directed towards the tongue of the bird," Applicants note that the throat of the bird proximate the base of the beak (B) is actually depicted as being spaced apart from (i.e., not in contact with) the surface 68 of the opening 69. As a result, this assertion is not supported by Figure 5 because no portion of the device is in contact with the bird proximate the base of the lower beak.

Applicants also note that it is asserted that "the energy is incident on the beak exposed proximate the second major side of the bird head positioning device while pressing inward on the throat of the bird (Gorans Col. 3 line 18-22)." A review of the cited portion of *Gorans et al.* reveals that no discussion is provided to support the assertion that energy is delivered "while pressing inward on the throat of the bird."

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It is also asserted, in support of this rejection, that "*Gorans* . . . is silent on treating the lower beak." Applicants disagree, noting the above discussion with respect to the stated advantage of *Gorans et al.*, i.e., "that the invention allows the bird to retain its lower beak which helps in eating and drinking." *Gorans et al.*, col. 2, lines 2-5.

With respect to claims 2 and 3, the arguments presented above with respect to claim 1 also apply to the assertions presented in support of the rejections of claims 2 and 3.

With respect to claims 6 and 11, Applicants note that it is asserted that "*Gourlandt* teaches the bird head positioning device comprises a tongue control protrusion, wherein the tongue control protrusion presses into the throat of the bird proximate the base of the lower beak (*Gourlandt* Col. 4 line 51-59)." Applicants disagree. The cited passage of *Gourlandt* is presented below:

Each of said supports 30 further comprises a control member 62 constituted for instance by a rod located in the path of a bird being loaded into said support 30 and for this purpose it extends horizontally across recess 54, and is bent to extend into the recess. An alternative configuration for control member 62 is to extend straight across notch 21 below the front piece 50, as at 62' in FIG. 6a, in which case it acts against the bird's neck rather than between its beaks.
Gourlandt, col. 4, lines 51-59.

The cited passage of *Gourlandt* does not support the assertion that "the tongue control protrusion presses into the throat of the bird proximate the base of the lower beak." Rather, *Gourlandt* teaches that the control member 62 "acts against the bird's neck" or "between its beaks."

With respect to claims 4, 5, and 7, Applicants submit that because *Gorans et al.* does not teach or suggest the methods recited in independent claims 1 or 6, the assertions made in support of the rejections of claims 4, 5, and 7 do not support a *prima facie* case of obviousness.

With respect to claim 8, Applicants note that *Gourlandt* does not teach that "the tongue control protrusion presses into the throat of the bird proximate the base of the lower beak" as recited in claim 6 (from which claim 8 depends).

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With respect to claim 15, Applicants respectfully submit that *Gourlandt* does not teach that "the tongue control protrusion presses into the throat of the bird proximate the lower beak of the bird" as is recited in independent claim 15. In this regard, see Applicants' discussion with respect to claims 1, 6, and 11.

With respect to claims 10, 12, and 16, Applicants submit that the control member 62 is designed to be moved as a bird head is inserted into the recess 54 (*see, e.g., Gourlandt*, col. 5, lines 24-25). As a result, the control member 62 is not "fixed" or stationary as asserted in support of the rejections of claims 10, 12, and 16.

With regard to the rejections of claims 14 and 18, reference no. 70 of *Gorans et al.* is cited as teaching a resilient member. Applicants note, however, that reference no. 70 identifies a light bulb, not a resilient member. *See, e.g., Gorans et al.*, col. 3, line 62 to col. 4, line 2. As a result, the assertions made with respect to claims 14 and 18 cannot support a *prima facie* case of obviousness with respect to claims 14 and 18.

For at least the above reasons, Applicants respectfully submit that a *prima facie* case of obviousness has not been established with respect to claims 1-18. Reconsideration and withdrawal of the rejection of claims 1-18 over *Gorans et al.* in view of *Gourlandt* are, therefore, respectfully requested.

Claim Objections

The Examiner objected to claims 11 and 15 due to informalities. Applicants are, however, unclear as to the basis for the objection. Furthermore, if amended as proposed, the amended clause of claim 11 would read as follows:

the bird head positioning device ~~adapted to position~~ positioned the head of a bird proximate the first major side

If amended as proposed, the amended clause of claim 15 would read as follows:

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a bird head positioning device ~~adapted to position~~ positioned the head of a
bird such that at least a portion of the beak of the bird . . .

As demonstrated above, the amended clauses would likely serve as the basis for further objections. As a result, Applicants have declined to make the proposed amendments, but would welcome the opportunity to discuss the reasoning for the objections to claims 11 and 15 and make amendments if appropriate.

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It is respectfully submitted that the pending claims 1-18 are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted by


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Date
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Direct Dial (612) 305-1218**CERTIFICATE UNDER 37 CFR §1.8:**

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to **Mail Stop Amendment**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 11th day of January, 2006, at 1:40 PM (Central Time).

By: Name: KEVIN W. RAASCH